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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91204986
Party	Plaintiff Xylem Group, LLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application No. 85/386,849 filed on August 7, 2011
For the Trademark "XYLEM" (Stylized) in International Classes 1, 6, 7, 9, 11, 35, 36,
37, 40 and 42

XYLEM GROUP, LLC.)	
)	
Opposer)	
)	
v.)	Opposition No. 91204986
)	
XYLEM IP HOLDINGS LLC.)	
)	
Applicant.)	

MOTION TO SUSPEND PENDING THE DECISION OF
THE UNITED STATES DISTRICT COURT FOR THE
NORTHERN DISTRICT OF GEORGIA ATLANTA DIVISION

Opposer, XYLEM GROUP, LLC. (hereinafter "Opposer") a limited partnership organized under the laws of Georgia, with a principal place of business at 205 Hembree Park Dr., Ste. 130, Roswell Georgia 30076, hereby through its attorney moves to suspend the above-captioned proceeding pending disposition of a civil action initially filed in the United States District Court for the Southern District of New York, No. 11 CIV. 5783 by ITT CORPORATION AND XYLEM INC., parties in privity with the Applicant. This civil action was subsequently refiled in the United States District Court for the Northern District of Georgia Atlanta Division, No. 1:11 CIV. 3669-JEC.

Applicant, a party in privity with ITT CORPORATION AND XYLEM INC., originally filed the above-identified intent to use trademark application under the

company name Water IP Holdings LLC to register the trademark “XYLEM” (Stylized) (Application No. 85/386,849) for various goods and services in International Classes 1, 6, 7, 9, 11, 35, 36, 37, 40 and 42. Water IP Holdings LLC changed its name to XYLEM IP Holdings LLC on October 10, 2011. The application was published for opposition on April 10, 2012.

Opposer filed a Notice of Opposition to Application Serial No. 85/386,849, claiming (1) that Opposer will be harmed by the registration of the mark XYLEM (Stylized), based on likelihood of confusion as to source, sponsorship or affiliation; (2) prior use of the mark XYLEM; (3) lack of intent to use; (4) intent to commit fraud; (5) likelihood of dilution; and (6) unfair competition based on the belief that the subsequent registration of Application No. 85/386,849 would be likely to cause confusion, or to cause mistake, or deceive as to the affiliation, connection or association of Applicant’s corporation with that of Opposer’s.

Believing itself not to infringe or dilute Opposer’s federal registered trademark or common law rights, ITT CORPORATION AND XYLEM INC., parties in privity with the Applicant, initially filed a civil action seeking a declaratory judgment that their use of the mark XYLEM does not infringe Opposer’s federal and common law rights. The pleadings in this civil action were initially filed in the United States District Court for the Southern District of New York, No. 11 CIV. 5783 by ITT CORPORATION AND XYLEM INC., parties in privity with the Applicant. The civil action was subsequently refiled on October 26, 2011 in the United States District Court for the Northern District of Georgia Atlanta Division, No. 1:11 CIV. 3669-JEC.¹ See, attached Exhibit A.

¹ The case was later reassigned as 1:11-CV-3669-WSD.

On December 12, 2011, Xylem Group filed its answer, defenses, and counterclaims asserting counterclaims for: (1) federal trademark infringement; (2) federal unfair competition; (3) unfair competition under Georgia law; (4) dilution in violation of Georgia law; (5) unfair competition under New York law; and (6) violation of New York law on anti-dilution.

Disposition of the civil action will determine whether use of the mark by ITT CORPORATION AND XYLEM INC., parties in privity with the Applicant, will result in a likelihood of confusion, dilution, and unfair competition. Accordingly, it is respectfully submitted that all further proceedings in Opposition No. 91204986 be suspended pending disposition of Civil Action No. 1:11 CIV. 3669-WSD.

Grounds for Motion

When a party to a case pending before the Trademark Trial and Appeal Board (TTAB) is also involved in a civil action that may have bearing on the decision to be rendered by the TTAB, the Board may suspend the proceeding until the final determination of the civil action. See, 37 C.F.R. § 2.117(a); TBMP § 510.02(a). This is because “a decision by the United States District Court would be binding on the Patent Office; whereas, a determination by the Patent Office as to respondent’s right to retain its registration would not be binding or res judicata in respect to the proceeding before the federal district court.” *Whopper-Burger, Inc. v. Burger King Corporation*, 171 U.S.P.Q. 805, 1971 WL 16554 (T.T.A.B. 1971). A court’s decision regarding the right to registration is binding on the TTAB. *Seven-Up Co. v. Bubble Up Corp.*, 50 C.C.P.A. 1012, 312 F.2d 472, 136 U.S.P.Q. 210 (1963); *see also, In re Alfred Dunhill Limited*, 224 U.S.P.Q. 501, 1984 WL 63164 (T.T.A.B. 1984); J. Thomas McCarthy, 4 *McCarthy on*

Trademarks and Unfair Competition (4th ed. 2006). ITT CORPORATION AND XYLEM INC., parties in privity with the Applicant, and Opposer are both parties to the civil action, which is currently pending before the Northern District of Georgia Atlanta Division.

Applicant “XYLEM IP HOLDINGS LLC” is a subsidiary of XYLEM INC. (Xylem, Inc.’s 4th Quarter 2011, 10-K filing with the SEC, p. 123). XYLEM INC. exercises exclusive control over XYLEM IP HOLDINGS LLC. Furthermore, ITT CORPORATION, also a party to Civil Action No. 1:11 3669-WSD, previously owned all the stock and exercised exclusive control over XYLEM INC. On October 31, 2011 XYLEM INC owner of XYLEM IP HOLDINGS LLC (“Applicant”), was “spun off” from ITT CORPORATION. The “spin off” occurred approximately 5 days after Civil Action 1:11 3669-WSD was filed with the District Court for the Northern District of Georgia, Atlanta Division. Moreover, it should be noted that Application No. 85/386,849 was filed August 2, 2011, two months prior to the “spin-off.” As such, ITT CORPORATION, the company with exclusively control over XYLEM INC and its subsequent subsidiaries, which include XYLEM IP HOLDINGS LLC (“Applicant”) was in direct privity with Applicant.

Attached hereto and marked Exhibit B is the Expert Report of Philip B. Hampton, II, an expert hired by ITT CORPORATION AND XYLEM INC., parties in privity with the Applicant, to provide testimony in the pending civil action in the United States District Court in Georgia, Atlanta Division. As set forth in paragraph 9 of Mr. Hampton’s report, ITT CORPORATION AND XYLEM INC. is collectively referred to as ITT. As set forth in paragraph 27 and 30 of Mr. Hampton’s report, ITT (through an affiliate) filed

Application Serial No. 85/371,193 and 85/386,849 to register the marks XYLEM and Xylem stylized. Mr. Hampton confirms that ITT CORPORATION AND XYLEM INC. is parties in direct privy with the Applicant. In addition, during the deposition of Peter Van Winkle, in house counsel for ITT CORPORATION, in the pending civil action in the United States District Court in Georgia, Atlanta Division the following testimony was provided (these pages are attached as Exhibit C):

Pg. 46 - P. VAN WINKLE

21 Q. The decision to create a company
22 called Water IP Holdings, LLC, tell me about
23 the decision to create that company.
24 A. That legal entity was created in
25 the context of the spinoff transaction. ITT

Pg. 47 - P. VAN WINKLE

2 had a holding -- an IP holding company called
3 ITT Manufacturing Enterprises Inc., I think,
4 at the time. And there are a number of
5 Trademarks and patents for ITT held in ITT
6 Manufacturing Enterprises. And at some point
7 when we completed the spinoff, we needed a
8 receiver for those assets. So Water IP
9 Holdings LLC were created for that.
10 Q. And there is some discussion either
11 before or after this email about wanting to
12 keep the filings of trademarks anonymous
13 at least from being named under the name of ITT.
14 What do you recall about that?
15 A. That's correct. That there was a
16 desire to keep the identity at least at the
17 time we were negotiating or at least prior to
18 making any kind of a trademark application
19 filing secret.

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3 Q. Was there any other reason for
4 forming Water IP Holdings LLC and registering
5 the trademarks under that name?
6 A. Water IP Holdings, LLC, was not
7 formed for the purpose of keeping trademarks
8 secret, the trademarks filing secret.

9 just happened to be-- it wasn't named by myself.
10 It was named by somebody else. As they were
11 creating new legal entities in the context of
12 the spin, they were naming them with what I
13 would call pretty generic names, water being
14 because it would -- there was WaterCo in the
15 spin, and there was DefenseCo in the spin,
16 so.

Pg. 51 - P. VAN WINKLE

22 Q. It looks like there's a decision
23 being made to reach out to the Spanish
24 company NA and engage them in coexistence
25 agreement discussions?

Pg. 52 - P. VAN WINKLE

2 A. Yeah. The trademark filing and the
3 reaching out to Xylema were at least being
4 contemplated as happening almost at the same
5 time. And I believe there was a -- from a
6 strategy perspective, we preferred to have to
7 try to lock in our rights first before
8 engaging in the negotiations.
9 And then I believe Frank had some
10 concerns about you know, not revealing the
11 identity of ITT, at least at the time, if
12 we went and engaged with NA first, then there
13 was a risk -- they probably wouldn't
14 deal with us anyways if they didn't
15 know who we were. So it was just really trying to
16 flesh out the strategy of filing first and
17 then negotiating.

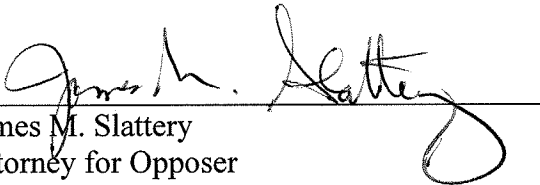
Notwithstanding this complex parent and subsidiary company structure, it is clear that both plaintiff's to the civil action are the same parties or at least those in privy, involving essentially the identical issues as are raised in the instant proceeding. In the pending civil action, the District Court will determine the rights of XYLEM INC (exclusive owner of XYLEM IP HOLDINGS LLC, Applicant) and XYLEM GROUP LLC ("Opposer") with respect to the "XYLEM" mark. It is clear that this determination

will directly affect the resolution of the issues before the TTAB. *See, The Other Telephone Company v. Connecticut National Telephone Company, Inc.*, 181 USPQ 125, 1974 WL 19878 (T.T.A.B. 1974).

Based on the foregoing, Opposer respectfully requests that the TTAB suspend this proceeding pending the final determination of the Civil Action.

Dated: August 24, 2012

Respectfully Submitted,

By 
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Attorney for Opposer
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CERTIFICATE OF SERVICE

I certify that a copy of Opposer's MOTION TO SUSPEND PENDING THE DECISION OF UNITED STATES DISTRICT COURT FOR THE NORTHERN DISTRICT OF GEORGIA was served by first class mail postage prepaid to:

Jason K. Schmitz, counsel for Applicant, at
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August 24, 2012

By Tiffany C. Johnson

EXHIBIT A

**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF GEORGIA
ATLANTA DIVISION**

ITT CORPORATION and)	
)	
XYLEM INC.,)	
)	
Plaintiffs,)	
)	
v.)	Civil Action
)	
)	File No. 1:11-CV-3669-WSD
XYLEM GROUP, LLC,)	
)	
Defendant.)	
_____)	

EXPERT REPORT OF PHILIP G. HAMPTON, II

1. This constitutes an Expert Report prepared by me, Philip G. Hampton, II, pursuant to Federal Rule of Civil Procedure 26(a)(2)(B), in connection with the above-referenced matter. I have been retained as an expert in the above-captioned case by counsel on behalf of plaintiffs to offer an expert opinion regarding various trademark issues raised in the instant matter.

2. I reserve the right to supplement the opinions set forth herein based on additional information provided to me or in response to expert reports submitted by defendant. In reaching my opinions as expressed herein, I reviewed the materials identified in Exhibit A to this report.

3. I have been an intellectual property law attorney for more than thirty years. I am a member of the Bars of the State of New York, the District of Columbia and the United States Patent and Trademark Office.

4. I received a S.B. degree and a S.M. degree in Chemical Engineering from the Massachusetts Institute of Technology in 1977, and my J.D. degree from the University of Chicago in 1980.

5. From 1980 until 1993, and continuously since 1998, I have been engaged in the private practice of intellectual property law. During my years in private practice, my practice has been limited to intellectual property law and almost exclusively to patent and trademark law. In the trademark area, I have prosecuted domestic and foreign trademark applications, conducted cancellation and opposition proceedings before the Trademark Trial and Appeal Board and litigated trademark infringement and unfair competition cases before various federal district courts. While in private practice, I have served in leadership positions in several intellectual property law associations, including the American Intellectual Property Law Association, the International Trademark Association and the IP Law Section of the American Bar Association and the National Bar Association. I have also given numerous presentation on a wide variety of intellectual property law topics.

6. On November 4, 1993, President Clinton announced his intention to nominate me to become the Assistant Commissioner for Trademarks at the United States Patent and Trademark Office ("PTO"). While I was confirmed as the Assistant Commissioner for Trademarks by the United States Senate on May 6, 1994, I began my tenure at the PTO on December 9, 1993, as the Assistant Commissioner for Trademarks - Designee. I served as the Assistant Commissioner for Trademarks until I returned to the private practice of law on October 15, 1998.

7. As the Assistant Commissioner for Trademarks, I was the CEO of the trademark operations at the PTO and responsible for the day-to-day operation and policy direction of the Trademark Office. I testified before Congress on proposed legislation, represented the United

States at diplomatic conferences and other international meetings, oversaw the re-engineering of the Trademark Office and was responsible for the policies of the Trademark Office, including examination policies related to Sections 2(d) of the Lanham Act, i.e., namely, likelihood of confusion.

8. As part of my policy responsibilities, I issued more than 150 Commissioner's Decisions, reviewed every Letter of Protest, created the framework for the implementation of the Trademark Law Treaty and oversaw the issuance of a new edition of the Manual of Trademark Examining Procedure. In order to carry out my policy responsibilities, I was familiar with the trademark examination practices and procedures.

9. I have been retained as an expert in the above-captioned case by counsel on behalf of Plaintiffs, ITT Corporation and Xylem Inc. (collectively, "ITT"), to offer expert testimony regarding the nature, quality and content of ITT's trademark clearance process preceding the adoption of the XYLEM mark for its water technology spin-off; the determination of the United States Patent and Trademark Office that the parties' respective marks are not confusingly similar; and ITT's dealings with Novedades Agricola S.A. ("Novedades") concerning its XILEMA mark.

10. Attached as Exhibit B to this report is a copy of the most current version of my curriculum vitae, which further describes my professional experience and qualifications in the areas of trademark law and as an expert witness. As an expert witness for the plaintiffs, my law firm [?] will be compensated at the rate of \$700.00 per hour.

11. I have been an expert witness and prepared expert reports and provided deposition testimony as an expert witness in all areas of trademark law, including examination policies and procedures of the PTO, likelihood of confusion and infringement. Attached as Exhibit C and Exhibit D, respectively are a list of the cases at which I have been retained as an expert witness and cases [?] in which I have served as a special master.

12. As a trademark practitioner for more than thirty years, I am familiar with the process used to select and clear trademarks for adoption and use. I am also familiar with how to gauge the strength of a trademark and the legal and practical ramifications of a relatively weak trademark.

13. As a former Assistant Commissioner for Trademarks and an experienced practitioner, I am familiar with how trademark applications and registrations are examined and maintained at the PTO. I am also quite familiar with the training provided to Trademark Examining Attorneys to ensure that trademark applications are properly examined.

I. ITT's Adoption of the Name and Mark XYLEM

14. On January 12, 2011, ITT announced its intent to transform itself into three publicly-traded companies – a manufacturing company, a water technology company, and a defense and security company. A group of ITT executives were charged with naming the water and fluid-management company.

15. To assist it in the naming and branding of the water technology company, ITT hired Lippincott, a brand consulting company. Initially, Lippincott proposed seventeen possible names for the water technology company. After discussions with the ITT executives, including several who would assume management responsibilities in the water technology company, the list of possible names/trademarks was narrowed to seven. Because the water technology company and its brand would be used world-wide, ITT's outside trademark counsel, Baker & McKenzie International ("B&M"), conducted world-wide trademark searches for each of the proposed trademarks.

16. B&M presented its search results in a comprehensive search report in late May 2011. The sole focus of the B&M report was the prospect of securing trademark registration in the various jurisdictions. The report noted: "This report is . . . only

indicative of the likelihood of registration of each trademark concerned Once the choice is made or narrowed down, it may become advisable to deepen the analysis for the trademark of choice.” The report also noted that it was based on the assumption the mark would be used on several very general product categories. It noted that after more detailed consideration of the intended product uses, “some of the obstacles pointed out [might] become less relevant.

17. Although, in the U.S., registration of a trademark in light of preexisting uses of similar marks is governed by a standard that is generally similar to the standard employed by courts in determining trademark infringement, determinations of registrability (and attorneys’ predictions of registrability when counseling their clients) are usually more conservative (i.e., more likely to rule against the newcomer) than infringement determinations. This is due in part to the fact that when assessing registrability the U.S. PTO considers a narrower range of facts and circumstances than does a court in an infringement case. For instance, unless an application specifically declares that sale of the applicant’s goods/services will be through specific channels of trade, the PTO assumes that all possible channels of trade will be used.

18. In its overall assessment, B&M opined that there might be “high difficulty” in obtaining trademark protection for a XYLEM mark in the U.S. Similarly, it opined that there might be high difficulty in obtaining trademark protection for three of the other marks in at least one of the primary countries in which the water technology company planned to operate.

19. B&M’s report noted that there were risks to obtaining trademark protection for goods in the relevant classes (International Classes 6, 7, 9 and 11) in five primary countries, along with several EU counties. In at least half of those countries, B&M noted that XILEMA or XYLEMA registrations owned by Novedades created the potential

impediment to trademark protection. Only in the United States was the XYLEM mark owned by Xylem Group found to be a possible impediment.

20. Incorporating the trademark searches of B&M, on June 2, 2011, Lippincott presented a document “Naming the new water company-summary of full legal, linguistic and URL evaluations.” This report assessed the risk of adopting XYLEM as the trademark for the water company as “low/medium” (p. 6). Lippincott also noted that there may be a higher hurdle to registration of XYLEM “[b]ecause XYLEM is a descriptive, real term” (p. 28).

21. After receiving Lippincott’s report, there were extensive communications over a six-week period among various executives and in-house attorneys at ITT, and with outside trademark counsel, regarding adoption of the name and trademark for the water technology company. Counsel considered the risks of adopting XYLEM in light of preexisting uses of that mark by third parties. There was specific considerations of the risks of adopting XYLEM in light of the U.S. registration held by Xylem Group. After investigating and considering the matter, counsel concluded that the risks associated with the preexisting Xylem Group mark were low, and so advised senior management. On July 14, 2011, ITT announced that the water technology company would be named XYLEM.

22. The process used by ITT in choosing XYLEM as the name and trademark for its water technology business was almost a textbook example of the proper way for a company to clear and adopt a name. Initially, either with or without a consultant, a number of potential marks are proposed – some because of sound or written appearance, others because they somehow suggest the product or service or suggests a desirable attribute of the product or service. Then each proposed trademark is searched to determine whether it is available for use and registration. Rarely does a trademark search find absolutely no risk associated with the use and/or registration of a proposed mark. Instead,

business and marketing people, along with their attorneys, must decide on a particular mark based upon several factors, including common law uses of the mark, third-party uses of a similar mark and the world-wide availability of the mark.

23. From my review of the reports produced by Lippincott, the trademark search report produced by B&M and the extended email discussions among executives, in-house lawyers and outside counsel, it is my opinion that ITT adopted the name and mark XYLEM for its water technology business after appropriately and reasonably taking into account all of the relevant factors. There is no indication that ITT believed there would be any marketplace confusion upon its adoption of the name and mark XYLEM or that it disregarded Xylem Group's trademark rights.

II. US PTO Correctly Found Marks Not Confusingly Similar

24. As part of their training, new Examining Attorneys are taught to search the Principal and Supplemental Registers for marks in prior filed applications and registrations that may cause a likelihood of confusion with the applicant's mark. Examining Attorneys are taught to consider a number of factors in determining whether two marks are confusingly similar, not just the similarity in sight, sound and meaning of the marks, and the relatedness of the identified goods and services. Examining Attorneys are also taught that under the doctrine of foreign equivalents, two marks are identical if they are merely translations of one another. If an Examining Attorney is found to have approved a mark for publication that is likely to cause confusion with a prior filed or registered mark, the error is noted in the Examining Attorney's performance appraisal.

25. On December 14, 1995, Novedades filed Application Serial No. 75/032,605 for its XILIMA trademark for various products used in connection with its irrigation business. The application was reviewed by the USPTO, which found that there were no

confusingly similar U.S. trademarks or applications. In a June 16, 1996, Office Action, the Examining Attorney asked whether XILEMA had any significance in the relevant trade or any geographical significance or if it had any meaning in a foreign language. On December 9, 1996, Novedades' counsel informed the Examining Attorney that XILIMA was Spanish for XYLEM. On December 11, 2001, the '605 application issued as U.S. Trademark Reg. No. 2,515,972 for "water distribution apparatus, namely irrigation sprinklers, plumbing fittings, namely valves, cocks and bibs" and for "the storage and delivery of irrigation and fertilization apparatus and products for others."

26. On December 5, 2005, Xylem Group filed Application Serial No. 78/766,777 to register XYLEM for various bathroom and kitchen fixtures and lighting fixtures and for bathroom furniture. In reviewing the '777 application, the Examining Attorney did not conclude that the '972 registration was confusing similar to it, even though (1) "XILEMA" is Spanish for "XYLEM" and under the doctrine of foreign equivalents is deemed identical to XYLEM for purposes of analysis, and (2) and both marks are used on goods involving water. The '777 application issued as U.S. Trademark Reg. No. 3,183,362 on December 12, 2006.

27. On July 14, 2011, ITT (through an affiliate) filed Application Serial No. 85/371,193 for XYLEM for scores of different water-related goods and services, including marine toilets. On November 9, 2011, the PTO issued an Office Action in which the Examining Attorney determined that the mark covered by the '193 application was confusingly similar to the mark covered by the '362 registration, the XYLEM mark owned by Xylem Group. According to the Examining Attorney, the marks were identical and there was at least some overlap of goods. But, the only overlap the Examining Attorney cited was as to marine toilets claimed in ITT's application. The Examining Attorney also found that the '193 application might be confusingly similar to pending Application Serial No. 85/222,988 for XYLEM, owned by AqueSys, Inc. for ophthalmic surgical devices.

28. In its two responses to the Office Action, ITT correctly pointed out that mere identity of the marks is not enough – the goods and services, channels of trade and sophistication of customers must also suggest that the marks would be confused. Specifically, after deleting marine toilets, ITT pointed out that goods were not so similar as to be confusing, particularly since each party's goods would be expected to be sold in widely disparate channels of trade and that purchasers of ITT's goods were highly sophisticated, making confusion almost impossible. The Examining Attorney accepted this argument.

29. On April 10, 2012, the '193 application was published. The '193 application was opposed by Defendant on May 1, 2012.

30. On August 2, 2011, ITT (through an affiliate) filed Application No. 85/386,849 to register a stylized XYLEM mark for the same of goods as was covered by the '193 application. As with the '193 application, the PTO originally found the mark confusingly similar to the '362 registration. But. After ITT submitted the arguments as it had during the prosecution of the '193 application, the '849 application was allowed, published and opposed by the Defendant.

31. In light of PTO rules and procedures, the sequence of events described above shows unambiguously that the PTO concluded that, except as to marine toilets, there is no likelihood of confusion between ITT's XYLEM mark and the XYLEM mark of Xylem Group. The PTO reached that conclusion even though ITT's applications were not restricted as to the channels of trade in which ITT proposed to use the marks.

III. Novedades Has a Stronger Worldwide Trademark Position than Xylem Group

32. XYLEM is not a made-up, or coined, term. Rather, it is a defined word meaning "a compound tissue in vascular plants that help provide support and that conducts water and nutrients ..." (Dictionary.com). In other words, XYLEM when used as a

trademark suggests “water.” Therefore, since under U.S. trademark law, the XILEMA mark owned and used by Novedades and the XYLEM mark owned and used by Defendant are weak marks and Plaintiff’s goods were not similar to those of either company, those marks did not create a significant risk to ITT’s use and registration of its XYLEM mark in the United States.

33. In the United States, the goods and/or services for which the mark is used must be identified with specificity. However, in many jurisdictions around the world, the goods and/or services can be specified generally. For example, Novedades’ Chilean registration for XILEMA covers “distribution machines for water and irrigation.” And in countries such as Argentina,, an applicant has to specify the entire class of goods or services.

34. My review of ITT’s clearance process indicates that ITT concluded that it did not wish to adopt the XYLEM name unless it could secure a coexistence agreement with Novedades, the owner of the XILEMA mark. ITT did not take that position with respect to Xylem Group’s XYLEM mark. In my opinion, that different treatment was justified. Novedades had (and has) a much stronger trademark position vis-à-vis a XYLEM trademark than Xylem Group.

35. The B&M report disclosed that Novedades (or affiliates) holds registrations for XILEMA in multiple significant markets in which ITT operates – Argentina, Brazil, Chile, Mexico, Venezuela (XYLEMA), the United States, Spain, and France. ITT’s investigation revealed that the goods upon which Novedades was using its XILEMA trademark were only somewhat similar or complementary to goods upon which ITT was planning to use a XYLEM trademark. Therefore, while ITT believed its goods were different from Novedades’ goods and that Novedades had less than a 50% chance of blocking ITT’s registration of the XYLEM mark in any particular country, ITT concluded that given the number of countries involved, the risk of being blocked from registration in at least one

significant market was unacceptably high. By contrast, Xylem Group owns a registration in only one jurisdiction, the United States, for goods that are dissimilar to those of ITT. Consequently, ITT concluded that the risk of Xylem Group preventing it from obtaining a registration for its XYLEM trademark in any significant jurisdiction was very low.

36. I understand that, in exchange for Novedades' entering a coexisting agreement, ITT paid Novedades 200,000 Euros, equivalent to about \$250,000. In my opinion, if one were to assume (contrary to the facts and ITT's own conclusion) that there is an arguable likelihood of confusion between ITT's XYLEM mark and Xylem Group's XYLEM mark, the value of a coexistence agreement with Xylem Group as of July 2011 would have been significantly less than \$250,000.

37. The opinions stated in this written report are based on my education, background, knowledge and experience in trademark law and my review of the information currently available to me. As noted above, I reserve the right to expand upon or modify my opinions and/or offer additional opinions in response to any information that becomes available to me in connection with any matters raised by defendant and/or any opinions provided by any experts retained by defendant.

Date: June 20, 2012

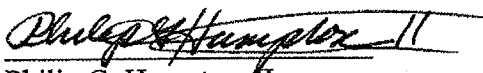
By: 
Philip G. Hampton, II

Exhibit A
Materials Reviewed

File history of Registration No. 2,515,972

File history of Registration No. 3,183,362

File history of Application Serial No. 85/371,193

File history of Application Serial No. 85/386,849

Emails regarding clearance process

1/11/2012	Initial Disclosures of Defendant
1/11/2012	Plaintiff's Initial Disclosures
10/26/2011	Complaint
12/12/2011	Answer and Counterclaims
7/20/2011	Cease and desist letter from James M. Slattery
7/26/2011	Robert Shaughnessy's response to cease and desist letter
8/1/2011	2 nd cease and desist letter from James M. Slattery
5/1/2012	Notice of Opposition regarding Application Serial No. 85/386,849
5/1/2012	Notice of Opposition regarding Application Serial No. 85/371,193
5/ - /2011	Trademark search report authored by Baker & McKenzie
6/2/2011	Lippincott Presentation: "Naming the New Water Company"
	File History of Registration No. 2,515,972
	File History of Registration No. 3,183,362
	File History of Application Serial No. 85/371,193

File History of Application Serial No. 85/386,849

4/27/2011	Trademark Search Report
2/14/2011	ITT Corporation's Strategic Business Transformation and Brand Development Program Request for Proposals
3/30/2011	Lippincott Presentation: "The Future of ITT: Positioning Three Distinct Brands for Growth"
4/25/2011	Lippincott Presentation: "ITT Brand Strategy Positioning and Naming Options for Water Company"

Exhibit B

CURRICULUM VITAE for PHILIP G. HAMPTON, II

PUBLIC SECTOR EXPERIENCE

**Assistant Commissioner — United States Patent and Trademark Office,
Washington, D.C. (1993-1998)**

As CEO of the Trademark Office

- oversaw the re-engineering of the Trademark Office that reduced front-end processing time from 145 days to 23 days and saw revenues outpace expenditures every year,
- oversaw substantive policy changes, including the issuance of more than 150 Commissioner's Decisions and a new edition of the Manual of Trademark Examining Procedure

As an Executive of the Patent and Trademark Office

- testified before Congress on proposed legislation
- represented the United States at diplomatic and technical conferences, including as Deputy Head of Delegation at the 1994 Trademark Law Treaty Diplomatic Conference, Head of Delegation at 1997 CARICOM Conference on TRIPPS implementation in Fort of Spain, Trinidad and as the senior U.S. government representative and speaker at 1998 U.S.-Israel High Technology Conference in Tel Aviv
- made presentations to stakeholders of the U.S. intellectual property system, including bar associations, trade associations and academic institutions, on the operations and policy initiatives of the Patent and Trademark Office
- provided senior level input on proposed changes to the Patent Act, the PTO rules of practice and die Manual of Patent Examining Procedure

PRIVATE SECTOR EXPERIENCE

Haynes and Boone LLP, Washington, DC (2012 -); **Dickstein Shapiro LLP**, Washington, DC (2004 - 2012); **Gardner, Carton & Douglas**, Washington, DC (1998 -2004); **Kenyon &Kenyon**, New York, NY and Washington, DC (1980-1993)

Expert Witness - Prepared reports and provided testimony as an expert witness in all areas of trademark law, with an emphasis on the prosecution of trademark applications in the USPTO. Prepared expert report regarding whether patent advice was legally sufficient.

Special Master - Appointed by Judges Alexander Williams and Marvin Garbis (U.S. District Court for the District of Maryland) to handle pre-trial matters, including potentially dispositive motions, in patent infringement actions.

Litigation - Involved In all aspects of patent and trademark litigation (including as first chair) in U.S. district courts, mini-trials, ITC Section 337 hearings and Trademark Trial and Appeal Board opposition and cancellation proceedings.

Trademarks - Prepared, filed and prosecuted U.S. and foreign trademark applications; prepared trademark opinion letters; prepared validity and infringement opinions; prepared and filed of appeals to the Trademark Trial and Appeal Board; prepared and prosecuted oppositions and cancellations.

Licensing - Prepared licensing and merchandising agreements based on patents, trademarks, trade secrets and copyrights; negotiated the transfer of intellectual property and prepared documents pursuant to corporate acquisitions; prepared state and federal disclosure documents and the franchise agreement for a new, national franchisor.

ACADEMIC CREDENTIALS

J.D. University of Chicago Law School, Chicago, Illinois (1980).
S.B.,S.M, Chemical Engineering, Massachusetts Institute of Technology, Cambridge, Massachusetts (1977). Thesis - "Dynamic Mechanical Properties of Network Polymers."

BAR MEMBERSHIPS

New York
District of Columbia
U.S. Patent and Trademark Office
U.S. Court of Appeals for the Federal Circuit
U.S. Claims Court
U.S. District Courts - Various

PROFESSIONAL AFFILIATIONS

Howard University School of Law

Adjunct Professor - Trademark Law (2009 -)

National Bar Association

Member-Executive Committee (1990-1993)
Member-Board of Governors (1989-1994)
Chair-Budget Committee (1992-1993)
Chair-Intellectual Property Law Section (1989-1991)

International Trademark Association

Firm Representative (1990-1993); (1998-2004)
Member-Parallel Imports Subcommittee (1999 - 2001)
Member - Classification Subcommittee (2004 - 2005)
Member - Government Officials Education & Training
Committee (2012 - 2013)

American Bar Association (Intellectual Property Law Section)

Co-Chair- Int'l Trademark Treaties and Laws Committee
(2008 - 2009)
Chair - PTO Relations (Trademarks) Committee (2005 - 2007)
Co-Chair-Trademark Legislation Committee (2007 - 2008)
Member - Long Range Planning Task Force (2004)
Liaison to ABA Commission on Racial and Ethnic Diversity
(2003 - 2005)

American Intellectual Property Law Association

Fellow (2008-)
Member - Board of Directors (2004 - 2007)
Chair-Membership Committee (2000 - 2002)

American Intellectual Property Law Education Foundation

President (2008-2011)
Vice President (2007 - 2008)

Trustee - (2004 -)
Chairman - Scholarship Committee (2004 - 2008)

CIVIC INVOLVEMENT

Master - Giles S. Rich American Inn of Court (2004 - 2007)
Member- Leadership Washington Class of 2005
Member-Visiting Committee, University of Chicago Law School (1995 – 1998)
Member - Intellectual Property Advisory Board, DePaul University College of Law (1999-2002)
Chairman - Independent Judicial Screening Panel for New York County Civil Court (1987)
Deputy State Whip (for Clinton/Gore) - Democratic National Convention (1992)
Candidate - Member, D.C. Board of Education (1990)
Trustee-Peoples Congregational United Church of Christ (1999 – 2005, 2006-2012)
Life Member - Kappa Alpha Psi Fraternity, Inc.

HONORS

One of "America's Top Black Lawyers," *Black Enterprise Magazine* (November 2003)
"A Top Minority IP Partner," *Diversity & the Bar* (May/June 2003)

SPEECHES AND PRESENTATIONS (TRADEMARKS) SINCE 2005

September 2011	<i>Intellectual Property Owners (IPO) Annual Meeting: "Ethics in Trademark Practice" (Panelist)</i>
March 2011	<i>Howard University 8th Annual Intellectual Property Law Seminar: "2010 Trademark Case Law Update"</i>
March 2010	<i>Howard University 7th Annual Intellectual Property Law Seminar: "IP Ownership Rights in Trade Names"</i>
February 2010	<i>Georgia State Bar Intellectual Property Program: "How the Internet is Reshaping Trademark Law"</i>

June 2009	<i>California State Bar - Intellectual Property in Entertainment and Media: "Meeting the IP Needs of Entertainment Clients in a Cost Effective Manner"</i>
March 2009	<i>Howard University 6th Annual Intellectual Property Law Seminar: "Trademarks; From Virtual World Use to Dawn Donut in the Internet Context"</i>
February 2009	<i>PLI - Navigating Trademark Practice Before the PTO 2009: "Trademark Prosecution — Other Substantive Refusals and Acquired Distinctiveness"</i>
March 2008	<i>Howard University 5th Annual Intellectual Property Law Seminar: "Trademarks: Acquisition, Protection and Exploitation - From Domain Names to Cyber-claims"</i>
February 2008	<i>PLI- Navigating Trademark Practice Before the PTO 2008: "Trademark Prosecution - Other Substantive Refusals and Acquired Distinctiveness"</i>
May 2007	<i>ALI-ABA —Internet Law for the Practical Lawyer: "Dealing With Cyberclaims"</i>
March 2007	<i>Howard University 4th Annual Intellectual Property Law Seminar: "Trademarks: Acquisition, Protection and Exploitation"</i>
February 2007	<i>PLI- Navigating Trademark Practice Before the PTO 2007: "Trademark Prosecution Other-Substantive Refusals and Acquired Distinctiveness"</i>
February 2006	<i>PLI – Navigating Trademark Practice Before the PTO 2006: "Ex Parte Appeals"</i>
October 2005	<i>Howard University 3rd Annual Intellectual Property Law Seminar: "Mastering Your Domain – An Introduction to Trademarks and Domain Names"</i>
May 2005	<i>D.C. Bar Luncheon Program: "The Future of the REDSKINS Trademark" (moderator)</i>
April 2005	<i>ALI-ABA – Internet Law for the Practical Lawyer: "Dealing with Cyberclaims"</i>
March 2005	<i>Minority Corporate Counsel Assn. – CLE Expo: "2004</i>

Year in Review – Patents and Trademarks”

February 2005 *PLI – Navigating Trademark Practice Before the PTO*
2005: “Petitions to the Commissioner”

Exhibit C

CASES AS TRADEMARK EXPERT (SINCE 2005)

PROVIDED ORAL TESTIMONY

1. *Cellco Partnership d/b/a Verizon Wireless v Nextel Communications, Inc.* (D. Del.) Civil Action No. 03-725-KAJ (Deposition testimony regarding Trademark Office practice, descriptiveness vs. genericism.)
2. *E.T. Browne Drug Co., Inc., v. Cococare Products, Inc.* (DJSIJ.) Civil Action No. 03-5442 (KSH) (Deposition testimony regarding Trademark Office practice, descriptiveness vs. genericness.)
3. *Vital Pharmaceuticals, Inc. v. Red Bull GmbH, et al* (S.D. Fla.) Civil Action No. 05-161704-CIV-ALTONAGA (Deposition testimony regarding relative strength of marks, confusing similarity, trade dress, PTO practice.)
4. *Rush Industries, Inc, v. Garnier, LLC, et al.* (E.D.N.Y.) Civil Action No. 2:05-CV-04910 (Deposition testimony regarding reverse confusion, relative strength of marks, confusing similarity, descriptiveness, PTO practice, bad faith.)
5. *HomeLife Communities Group v. HomeLife Realty Services Inc., et al* (N.D. Ga.) Civil Action No. L06-CV-1607-CC (Deposition testimony regarding PTO practice, abandonment, fraud on the Trademark Office)
6. *American Eagle Outfitters, Inc., et al v, Lyle & Scott Limited, et al* (W.D. Pa.) Civil Action No. 3G6-CV-00607-FXC (Fraudulent procurement of marks, abandonment, Trademark Office practice.)
7. *WMH Tool Group, Inc. v. Woodstock International, Inc., et al* (N.D. Ill.) Civil Action No. 07-CV-3885 (Deposition testimony regarding fraud on the Trademark Office, CBP enforcement of trademarks, common law trademarks)

PROVIDED AN EXPERT REPORTS / DECLARATIONS

1. *Sundlese, et al, v. Hornady Manufacturing Co., et al* (D. Idaho) Civil Action No. CV—01-0126
2. *Lutron Electronics Co., Inc. v. Genlyte Thomas Group, LLC, et al,* (E.D. Pa.), Civil Action No. 03-CV-04334 (LDD)
3. *Pittsburgh Home and Garden Shows, Inc., v. Scripps Networks, Inc.* (W.D. Pa.) Civil Action No. 03-1477
4. *Summit Hotel Properties, Inc., et al v. Choice Hotels International, Inc.* (American Arbitration Association) Case No. 16 114 166 11

Exhibit D

CASES IN WHICH I HAVE BEEN THE COURT-APPOINTED SPECIAL MASTER

1. *MedImmune Oncology, Inc. v. Sun Pharmaceutical Industries, Limited*
(D. Md.) Civil Action No. MJG-04-CV-2612
2. *Star Scientific, Inc. v. R.J. Reynolds Tobacco Co.* (D. Md.) Civil Action
No. MJG-01-1504
3. *Invitrogen Corp. v. Clontech Laboratories, Inc.* (D. Md.) Civil Action Nos.
AW-96-4080 and AW-00-1879

EXHIBIT B

**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF GEORGIA
Atlanta Division**

FILED IN CLERK'S OFFICE
U.S.D.C. - Atlanta

OCT 26 2011

JAMES N. HATTIS, CLERK
By *[Signature]*
Deputy Clerk

ITT CORPORATION and XYLEM INC.,

Plaintiffs,

v.

XYLEM GROUP, LLC,

Defendant.

JEC

1 No. **11-CV-3669**

COMPLAINT

Plaintiffs ITT Corporation ("ITT") and Xylem Inc., for their Complaint against Defendant Xylem Group, LLC, allege as follows on personal knowledge as to the facts concerning themselves and on information and belief as to all other facts.

The Nature of the Action

1. Through this action Plaintiffs seek a declaratory judgment that their use of the trademark and name XYLEM in connection with the water technology business of Plaintiff ITT – soon to be spun off into a separate publicly-traded company, Plaintiff Xylem Inc. – does not infringe Defendant's federally registered trademark XYLEM for bathroom furniture and fixtures.

The Parties

2. ITT is a corporation organized under the laws of the State of Indiana, with its principal place of business in White Plains, New York. ITT is a global multi-industry high-technology engineering and manufacturing organization with operations in more than sixty countries. Its products and services focus on three main markets: global defense and security; water technology; and highly engineered industrial products. In January 2011, ITT announced that it would spin off its global defense and security business and its water technology business into separate public companies. In July 2011, ITT announced that, after the spin-off, the public company that will own and operate the water technology business will be named Xylem Inc.

3. Xylem Inc. is a corporation organized under the laws of the State of Indiana with its principal place of business in White Plains, New York. Following the spin-off described in the preceding paragraph, Xylem Inc. will own and operate the water technology business currently owned and operated by ITT. On October 5, 2011, the board of directors of ITT gave final approval to the spin-off, which is expected to occur on October 31, 2011.

4. Defendant is a limited liability company organized under the laws of the State of Georgia, with its principal place of business in Roswell, Georgia.

Defendant is in the business of designing, manufacturing, and selling certain types of bathroom furniture and fixtures.

Jurisdiction and Venue

5. This Court has subject-matter jurisdiction over this action under 15 U.S.C. § 1121(a); and 28 U.S.C. §§ 1331, 1338, and 2201.

6. Defendant is subject to personal jurisdiction in this Court because Defendant is organized under Georgia law and has its principal place of business in Georgia.

7. Venue is proper in this District under 28 U.S.C. § 1391 because Defendant resides (has its principal place of business) in this District.

8. This action is properly assigned to the Atlanta Division of this Court because Defendant's principal place of business is in Fulton County, Georgia.

Facts

9. The water technology business of ITT consists of two segments, Water Infrastructure and Applied Water.

10. Water Infrastructure focuses on the transportation, treatment, and testing of water. Its products include water and wastewater pumps; filtration systems; ultraviolet light and ozone disinfection equipment; analytical instruments for testing water quality (such as pH and dissolved oxygen); and systems and controls relating to such equipment. The products are marketed under brands such

as Flygt, Wedeco, Godwin Pumps, WTW, Sanitaire, AADI, Ebro, and Leopold. Water Infrastructure customers are typically public water utilities and water infrastructure engineering and construction organizations.

11. Applied Water is directed to certain uses of water in the commercial, industrial, agricultural, and building services markets. Applied Water products include well and HVAC circulation pumps; fire pumps; irrigation pumping systems; HVAC control valves; heat exchangers; boiler sensors and controls; and beverage (soft drinks, beer, juice) dispensing equipment. Key brands include Goulds, Bell & Gossett, AC Fire, Standard, Flojet, Rule, Lowara, Jabsco, Hoffman Specialty, McDonnell & Miller, and Flowtronex. Applied Water customers are typically well drillers, HVAC contractors or system designers, beverage dispensing equipment distributors, and pumping systems integrators.

12. On July 14, 2011, ITT announced that, following the planned spin-off of its water technology business, that business will be named Xylem Inc. After the spin-off, Xylem Inc. will be an independent, publicly-traded company. The spin-off is expected to occur on October 31, 2011.

13. Defendant designs, manufactures, and sells certain types of bathroom furniture and fixtures. According to its website (*xylem.biz*), Defendant's product line consists of vanities and vanity tops; bathroom sinks; and bathroom faucets and

drains. It sells those products through dealers, typically, plumbing and bathroom supply houses.

14. Defendant owns Registration No. 3,183,362 on the Principal Register of the U.S. Patent and Trademark Office of the mark XYLEM for “bathroom and kitchen fixtures, namely, sinks, faucets, plumbing fittings, namely drains, bath drains, lavatory drains, vessel mounting rings, sink stops and sink riser tubes and lighting fixtures therefor, in Class 11” and for “bathroom furniture, namely vanities, shelves, medicine cabinets, countertops, and pedestals, in Class 20.” That registration issued on December 12, 2006.

15. On July 20, 2011, following ITT’s announcement that Xylem Inc. would own and operate the water technology business after its spin-off from ITT, counsel for Defendant sent a letter to ITT asserting that Plaintiffs’ use of the mark XYLEM infringes Defendant’s registered mark because such use is likely to cause confusion or mistake or to deceive consumers into believing that Defendant is associated with Plaintiffs. The letter demanded that Plaintiffs immediately stop using the mark XYLEM in connection with publications and goods related to “water treatment” worldwide. In several subsequent communications with Plaintiffs’ outside counsel, counsel for Defendant reiterated the assertion that Plaintiffs’ use of the mark XYLEM infringes Defendant’s registered mark, and again demanded that Plaintiffs immediately stop using the mark worldwide.

16. In fact, Plaintiffs' use of the mark XYLEM does not and will not cause a likelihood of consumer confusion.

17. ITT's water technology business does not compete with Defendant. ITT does not make or market bath furniture or fixtures, as Defendant does. Indeed, ITT does not sell any products used in bathrooms. Plaintiffs have no intention of entering the market for such goods.

18. The relatively small proportion of ITT's product line that could have any application inside a home consists of pumps and valves used in heating systems. These products, like the vast majority of ITT's other products, are not sold through retail establishments; the few products that are sold at retail establishments (pumps and related equipment for boats and recreational vehicles) are sold through different retail establishments than those used by Defendant. In contrast to Defendant's decorative bathroom furniture and fixtures, for which the purchase decision made by the ultimate user – the homeowner – is driven primarily by product appearance, ITT's pumps and control valves used in residential heating systems are located out of daily sight, are never chosen based on aesthetic considerations, and are not marketed or sold directly to the homeowner. They are typically selected and purchased by heating system professionals.

19. The differences in the parties' respective products, customers, and trade channels make it extremely unlikely that any consumer would think that Defendant's products are connected with ITT or Xylem Inc., or vice versa.

20. In addition, the parties' respective products are relatively expensive durable goods as to which buyers exercise considerable care in making their purchasing decisions.

21. Accordingly, Plaintiffs' use of the mark XYLEM does not and will not infringe Defendant's registered trademark.

Claim for Relief
Declaratory Judgment of Non-Infringement
of a Federally Registered Trademark

22. Plaintiffs incorporate by reference the allegations contained in paragraphs 1 through 21.

23. There currently exists between Plaintiffs and Defendant an actual, present, and justiciable controversy as to Plaintiffs' right to use the mark XYLEM.

24. Plaintiffs seek a declaratory judgment from this Court that their use of the mark XYLEM does not infringe Defendant's registered trademark XYLEM or otherwise violate Defendant's rights in that mark.

Prayer for Relief

Plaintiffs respectfully request that the Court:

- A. enter judgment declaring that Plaintiffs' use of the name and mark XYLEM does not infringe Defendant's registered trademark XYLEM or otherwise violate Defendant's rights in that mark.
- B. award Plaintiffs their costs in this action;
- C. award such other further relief to which Plaintiffs may be entitled, or which the Court determines to be just and proper.

Respectfully submitted,

McKENNA LONG & ALDRIDGE LLP

By: 

Gregory S. Brow
Georgia Bar No. 086422
gbrow@mckennalong.com
E. Claire Carothers
Georgia Bar No. 702045
ccarothers@mckennalong.com

303 Peachtree Street, N.E.
Suite 5300
Atlanta, GA 30308-3265
Ph.: (404) 527-4000
Fax: (404) 527-4198

Attorneys for Plaintiffs

Of Counsel:

WILLIAMS & CONNOLLY LLP

Robert J. Shaughnessy

Emmet T. Flood

Sarah F. Teich

725 12th Street, N.W.

Washington, D.C. 20005

Ph.: (202) 434-5000

Fax: (202) 434-5029

October 26, 2011

Local Form 440 (12/09) Summons in a Civil Action

UNITED STATES DISTRICT COURT

for the

Northern District of Georgia

ITT Corporation and Xylem Inc.

Plaintiff

v.

Xylem Group LLC

Defendant

Civil Action No.

1 11-CV-3669

SUMMONS IN A CIVIL ACTION

To: *(Defendant's name and address)*

Xylem Group LLC
205 Hembree Park Drive
Suite 130
Roswell, Georgia 30076

A lawsuit has been filed against you.

Within 21 days after service of this summons on you (not counting the day you received it) — or 60 days if you are the United States or a United States agency, or an officer or employee of the United States described in Fed. R. Civ. P. 12 (a)(2) or (3) — you must serve on the plaintiff an answer to the attached complaint or a motion under Rule 12 of the Federal Rules of Civil Procedure. The answer or motion must be served on the plaintiff or plaintiff's attorney, whose name and address are:

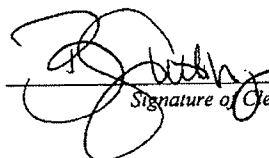
Gregory S. Brow
McKenna, Long & Aldridge LLP
303 Peachtree Street, N.E., Suite 5300
Atlanta, GA 30308-3265
(404) 527-4361
gbrow@mckennalong.com

If you fail to respond, judgment by default will be entered against you for the relief demanded in the complaint. You also must file your answer or motion with the court.

JAMES N. HATTEN

CLERK OF COURT

Date: OCT 26 2011


Signature of Clerk or Deputy Clerk

Local Form 440 (12/09) Summons in a Civil Action (Page 2)

Civil Action No. _____

PROOF OF SERVICE

(This section must be filed with the court unless exempted by Fed. R. Civ. P. 4 (l).)

This summons for *(name of individual and title, if any)* _____
was received by me on *(date)* _____.

☐ I personally served the summons on the individual at *(place)* _____
on *(date)* _____; or

☐ I left the summons at the individual's residence or usual place of abode with *(name)* _____
_____, a person of suitable age and discretion who resides there,
on *(date)* _____, and mailed a copy to the individual's last known address; or

☐ I served the summons on *(name of individual)* _____, who is
designated by law to accept service of process on behalf of *(name of organization)* _____
on *(date)* _____; or

☐ I returned the summons unexecuted because _____; or

☐ Other *(specify)*: _____
_____.

My fees are \$ _____ for travel and \$ _____ for services, for a total of \$ _____.

I declare under penalty of perjury that this information is true.

Date: _____

Server's signature

Printed name and title

Server's address

Additional information regarding attempted service, etc:

The JS44 civil cover sheet and the information contained herein neither replace nor supplement the filing and service of pleadings or other papers as required by law, except as provided by local rules of court. This form is required for the use of the Clerk of Court for the purpose of initiating the civil docket record. (SEE INSTRUCTIONS ATTACHED)

I. (a) PLAINTIFF(S)

ITT Corporation and Xylem Inc.

DEFENDANT(S)

Xylem Group LLC

(b) COUNTY OF RESIDENCE OF FIRST LISTED PLAINTIFF Westchester County, NY
(EXCEPT IN U.S. PLAINTIFF CASES)

COUNTY OF RESIDENCE OF FIRST LISTED DEFENDANT JEC
(IN U.S. PLAINTIFF CASES ONLY)

NOTE: IN LAND CONDEMNATION CASES, USE THE LOCATION OF THE TRACT OF LAND INVOLVED

(c) ATTORNEYS (FIRM NAME, ADDRESS, TELEPHONE NUMBER, AND E-MAIL ADDRESS)

Gregory S. Brow
McKenna, Long & Aldridge LLP
303 Peachtree Street, N.E., Suite 5300
Atlanta, GA 30308-3265
(404) 527-4361
gbrow@mckennalong.com

ATTORNEYS (IF KNOWN)

James M. Slattery
Birch Stewart Kolasch & Birch LLP
8110 Gatehouse Road, Suite 100E
Falls Church, VA 22042
(703) 205-8015
jms@bskb.com

II. BASIS OF JURISDICTION
(PLACE AN "X" IN ONE BOX ONLY)

- ☐ 1 U.S. GOVERNMENT PLAINTIFF ☒ 3 FEDERAL QUESTION (U.S. GOVERNMENT NOT A PARTY)
☐ 2 U.S. GOVERNMENT DEFENDANT ☐ 4 DIVERSITY (INDICATE CITIZENSHIP OF PARTIES IN ITEM III)

III. CITIZENSHIP OF PRINCIPAL PARTIES
(PLACE AN "X" IN ONE BOX FOR PLAINTIFF AND ONE BOX FOR DEFENDANT)
(FOR DIVERSITY CASES ONLY)

- | PLF | DEF | | PLF | DEF | |
|----------------------------|----------------------------|---|----------------------------|----------------------------|---|
| <input type="checkbox"/> 1 | <input type="checkbox"/> 1 | CITIZEN OF THIS STATE | <input type="checkbox"/> 4 | <input type="checkbox"/> 4 | INCORPORATED OR PRINCIPAL PLACE OF BUSINESS IN THIS STATE |
| <input type="checkbox"/> 2 | <input type="checkbox"/> 2 | CITIZEN OF ANOTHER STATE | <input type="checkbox"/> 5 | <input type="checkbox"/> 5 | INCORPORATED AND PRINCIPAL PLACE OF BUSINESS IN ANOTHER STATE |
| <input type="checkbox"/> 3 | <input type="checkbox"/> 3 | CITIZEN OR SUBJECT OF A FOREIGN COUNTRY | <input type="checkbox"/> 6 | <input type="checkbox"/> 6 | FOREIGN NATION |

IV. ORIGIN (PLACE AN "X" IN ONE BOX ONLY)

- ☒ 1 ORIGINAL PROCEEDING ☐ 2 REMOVED FROM STATE COURT ☐ 3 REMANDED FROM APPELLATE COURT ☐ 4 REINSTATED OR REOPENED ☐ 5 TRANSFERRED FROM ANOTHER DISTRICT (Specify District) ☐ 6 MULTIDISTRICT LITIGATION ☐ 7 APPEAL TO DISTRICT JUDGE FROM MAGISTRATE JUDGE JUDGMENT

V. CAUSE OF ACTION (CITE THE U.S. CIVIL STATUTE UNDER WHICH YOU ARE FILING AND WRITE A BRIEF STATEMENT OF CAUSE - DO NOT CITE JURISDICTIONAL STATUTES UNLESS DIVERSITY)

This is an action seeking a declaratory judgment (28 U.S.C. 2201) of non-infringement of a federally registered trademark (15 U.S.C. 1114 and 1125).

(IF COMPLEX, CHECK REASON BELOW)

- | | |
|---|---|
| <input type="checkbox"/> 1. Unusually large number of parties. | <input type="checkbox"/> 6. Problems locating or preserving evidence |
| <input type="checkbox"/> 2. Unusually large number of claims or defenses. | <input type="checkbox"/> 7. Pending parallel investigations or actions by government. |
| <input type="checkbox"/> 3. Factual issues are exceptionally complex | <input type="checkbox"/> 8. Multiple use of experts. |
| <input type="checkbox"/> 4. Greater than normal volume of evidence. | <input type="checkbox"/> 9. Need for discovery outside United States boundaries. |
| <input type="checkbox"/> 5. Extended discovery period is needed. | <input type="checkbox"/> 10. Existence of highly technical issues and proof. |

CONTINUED ON REVERSE

FOR OFFICE USE ONLY

RECEIPT # _____ AMOUNT \$ _____ APPLYING IFP _____ MAG. JUDGE (FP) _____
JUDGE _____ MAG. JUDGE _____ NATURE OF SUIT _____ CAUSE OF ACTION _____
(Referral)

JEC

840

28:1338v

VI. NATURE OF SUIT (PLACE AN "X" IN ONE BOX ONLY)**CONTRACT - "0" MONTHS DISCOVERY TRACK**

- ☐ 150 RECOVERY OF OVERPAYMENT & ENFORCEMENT OF JUDGMENT
- ☐ 152 RECOVERY OF DEFAULTED STUDENT LOANS (Excl. Veterans)
- ☐ 153 RECOVERY OF OVERPAYMENT OF VETERAN'S BENEFITS

CONTRACT - "4" MONTHS DISCOVERY TRACK

- ☐ 110 INSURANCE
- ☐ 120 MARINE
- ☐ 130 MILLER ACT
- ☐ 140 NEGOTIABLE INSTRUMENT
- ☐ 151 MEDICARE ACT
- ☐ 160 STOCKHOLDERS' SUITS
- ☐ 190 OTHER CONTRACT
- ☐ 195 CONTRACT PRODUCT LIABILITY
- ☐ 196 FRANCHISE

REAL PROPERTY - "4" MONTHS DISCOVERY TRACK

- ☐ 210 LAND CONDEMNATION
- ☐ 220 FORECLOSURE
- ☐ 230 RENT LEASE & EJECTMENT
- ☐ 240 TORTS TO LAND
- ☐ 245 TORT PRODUCT LIABILITY
- ☐ 290 ALL OTHER REAL PROPERTY

TORTS - PERSONAL INJURY - "4" MONTHS DISCOVERY TRACK

- ☐ 310 AIRPLANE
- ☐ 315 AIRPLANE PRODUCT LIABILITY
- ☐ 320 ASSAULT, LIBEL & SLANDER
- ☐ 330 FEDERAL EMPLOYERS' LIABILITY
- ☐ 340 MARINE
- ☐ 345 MARINE PRODUCT LIABILITY
- ☐ 350 MOTOR VEHICLE
- ☐ 355 MOTOR VEHICLE PRODUCT LIABILITY
- ☐ 360 OTHER PERSONAL INJURY
- ☐ 362 PERSONAL INJURY - MEDICAL MALPRACTICE
- ☐ 365 PERSONAL INJURY - PRODUCT LIABILITY
- ☐ 368 ASBESTOS PERSONAL INJURY PRODUCT LIABILITY

TORTS - PERSONAL PROPERTY - "4" MONTHS DISCOVERY TRACK

- ☐ 370 OTHER FRAUD
- ☐ 371 TRUTH IN LENDING
- ☐ 380 OTHER PERSONAL PROPERTY DAMAGE
- ☐ 385 PROPERTY DAMAGE PRODUCT LIABILITY

BANKRUPTCY - "0" MONTHS DISCOVERY TRACK

- ☐ 422 APPEAL 28 USC 158
- ☐ 423 WITHDRAWAL 28 USC 157

CIVIL RIGHTS - "4" MONTHS DISCOVERY TRACK

- ☐ 441 VOTING
- ☐ 442 EMPLOYMENT
- ☐ 443 HOUSING/ACCOMMODATIONS
- ☐ 444 WELFARE
- ☐ 440 OTHER CIVIL RIGHTS
- ☐ 445 AMERICANS with DISABILITIES - Employment
- ☐ 446 AMERICANS with DISABILITIES - Other

IMMIGRATION - "0" MONTHS DISCOVERY TRACK

- ☐ 462 NATURALIZATION APPLICATION
- ☐ 463 HABEAS CORPUS- Alien Detainee
- ☐ 465 OTHER IMMIGRATION ACTIONS

PRISONER PETITIONS - "0" MONTHS DISCOVERY TRACK

- ☐ 510 MOTIONS TO VACATE SENTENCE
- ☐ 530 HABEAS CORPUS
- ☐ 535 HABEAS CORPUS DEATH PENALTY
- ☐ 540 MANDAMUS & OTHER
- ☐ 550 CIVIL RIGHTS - Filed Pro se
- ☐ 555 PRISON CONDITION(S) - Filed Pro se

PRISONER PETITIONS - "4" MONTHS DISCOVERY TRACK

- ☐ 550 CIVIL RIGHTS - Filed by Counsel
- ☐ 555 PRISON CONDITION(S) - Filed by Counsel

FORFEITURE/PENALTY - "4" MONTHS DISCOVERY TRACK

- ☐ 610 AGRICULTURE
- ☐ 620 FOOD & DRUG
- ☐ 625 DRUG RELATED SEIZURE OF PROPERTY
- ☐ 21 USC 881
- ☐ 630 LIQUOR LAWS
- ☐ 640 R.R. & TRUCK
- ☐ 650 AIRLINE REGS.
- ☐ 660 OCCUPATIONAL SAFETY / HEALTH
- ☐ 690 OTHER

LABOR - "4" MONTHS DISCOVERY TRACK

- ☐ 710 FAIR LABOR STANDARDS ACT
- ☐ 720 LABOR/MGMT. RELATIONS
- ☐ 730 LABOR/MGMT. REPORTING & DISCLOSURE ACT
- ☐ 740 RAILWAY LABOR ACT
- ☐ 790 OTHER LABOR LITIGATION
- ☐ 791 EMPL. RET. INC. SECURITY ACT

PROPERTY RIGHTS - "4" MONTHS DISCOVERY TRACK

- ☐ 820 COPYRIGHTS
- ☒ 840 TRADEMARK

PROPERTY RIGHTS - "8" MONTHS DISCOVERY TRACK

- ☐ 830 PATENT

SOCIAL SECURITY - "0" MONTHS DISCOVERY TRACK

- ☐ 861 HIA (1395(f))
- ☐ 862 BLACK LUNG (923)
- ☐ 863 DIWC (405(g))
- ☐ 863 DIWW (405(g))
- ☐ 864 SSID TITLE XVI
- ☐ 865 RSI (405(g))

FEDERAL TAX SUITS - "4" MONTHS DISCOVERY TRACK

- ☐ 870 TAXES (U.S. Plaintiff or Defendant)
- ☐ 871 IRS - THIRD PARTY 26 USC 7609

OTHER STATUTES - "4" MONTHS DISCOVERY TRACK

- ☐ 400 STATE REAPPORTIONMENT
- ☐ 430 BANKS AND BANKING
- ☐ 450 COMMERCE/ICC RATES/ETC.
- ☐ 460 DEPORTATION
- ☐ 470 RACKETEER INFLUENCED AND CORRUPT ORGANIZATIONS
- ☐ 480 CONSUMER CREDIT
- ☐ 490 CABLE/SATELLITE TV
- ☐ 810 SELECTIVE SERVICE
- ☐ 875 CUSTOMER CHALLENGE 12 USC 3410
- ☐ 891 AGRICULTURAL ACTS
- ☐ 892 ECONOMIC STABILIZATION ACT
- ☐ 893 ENVIRONMENTAL MATTERS
- ☐ 894 ENERGY ALLOCATION ACT
- ☐ 895 FREEDOM OF INFORMATION ACT
- ☐ 900 APPEAL OF FEE DETERMINATION UNDER EQUAL ACCESS TO JUSTICE
- ☐ 950 CONSTITUTIONALITY OF STATE STATUTES
- ☐ 890 OTHER STATUTORY ACTIONS

OTHER STATUTES - "8" MONTHS DISCOVERY TRACK

- ☐ 410 ANTITRUST
- ☐ 850 SECURITIES / COMMODITIES / EXCHANGE

OTHER STATUTES - "0" MONTHS DISCOVERY TRACK

- ☐ ARBITRATION (Confirm / Vacate / Order / Modify)

(Note: Mark underlying Nature of Suit as well)

*** PLEASE NOTE DISCOVERY TRACK FOR EACH CASE TYPE. SEE LOCAL RULE 26.3**

VII. REQUESTED IN COMPLAINT:

☐ CHECK IF CLASS ACTION UNDER F.R.Civ.P. 23 DEMAND \$ Declaratory relief only

JURY DEMAND ☐ YES ☒ NO (CHECK YES ONLY IF DEMANDED IN COMPLAINT)

VIII. RELATED/REFILED CASE(S) IF ANY

JUDGE _____ DOCKET NO. _____

CIVIL CASES ARE DEEMED RELATED IF THE PENDING CASE INVOLVES: (CHECK APPROPRIATE BOX)

- ☐ 1. PROPERTY INCLUDED IN AN EARLIER NUMBERED PENDING SUIT.
- ☐ 2. SAME ISSUE OF FACT OR ARISES OUT OF THE SAME EVENT OR TRANSACTION INCLUDED IN AN EARLIER NUMBERED PENDING SUIT.
- ☐ 3. VALIDITY OR INFRINGEMENT OF THE SAME PATENT, COPYRIGHT OR TRADEMARK INCLUDED IN AN EARLIER NUMBERED PENDING SUIT.
- ☐ 4. APPEALS ARISING OUT OF THE SAME BANKRUPTCY CASE AND ANY CASE RELATED THERETO WHICH HAVE BEEN DECIDED BY THE SAME BANKRUPTCY JUDGE.
- ☐ 5. REPETITIVE CASES FILED BY PRO SE LITIGANTS.
- ☐ 6. COMPANION OR RELATED CASE TO CASE(S) BEING SIMULTANEOUSLY FILED (INCLUDE ABBREVIATED STYLE OF OTHER CASE(S)):

- ☐ 7. EITHER SAME OR ALL OF THE PARTIES AND ISSUES IN THIS CASE WERE PREVIOUSLY INVOLVED IN CASE NO. _____, WHICH WAS DISMISSED. This case ☐ IS ☐ IS NOT (check one box) SUBSTANTIALLY THE SAME CASE.

SIGNATURE OF ATTORNEY OF RECORD

October 26, 2011

DATE

EXHIBIT C

1
2 IN THE UNITED STATES DISTRICT COURT
3 FOR THE NORTHERN DISTRICT OF GEORGIA
4 ATLANTA DIVISION

5 -----X
6
7 ITT CORPORATION and
8 XYLEM INC.,

9 Plaintiffs,

10 vs.

Civil Action No.
1:11-CV-3669-WSD

11 XYLEM GROUP, LLC,

12 Defendant.
13 -----X

14 VIDEOTAPED DEPOSITION OF PETER VAN WINKLE

15 West Harrison, New York

16 Monday, June 25, 2012
17
18
19
20
21
22
23

24 Reported by:
25 JOAN WARNOCK
JOB NO. 328577B

1 P. Van Winkle

2 MR. SHAUGHNESSY: It's June.

3 MR. LaBRIOLA: Pardon me. June 7.

4 I don't know why -- everything I said
5 that referenced July should say June.

6 My apologies.

7 A. Okay.

8 Q. First, is the focus of this email
9 on the risks with regard to the Spanish
10 company that we'll call NA and attempts to --
11 whether or not to seek a coexistence
12 agreement with NA?

13 A. Which email are you referring to?
14 You have a number of emails in this.

15 Q. The very first one.

16 A. The very first one.

17 Q. On June 7 of 2011.

18 A. You know, at that time there was a
19 decision made to try and reach a coexistence
20 agreement with NA.

21 Q. The decision to create a company
22 called Water IP Holdings, LLC, tell me about
23 the decision to create that company.

24 A. That legal entity was created in
25 the context of the spinoff transaction. ITT

1 P. Van Winkle
2 had a holding -- an IP holding company called
3 ITT Manufacturing Enterprises Inc., I think,
4 at the time. And there are a number of
5 trademarks and patents for ITT held in ITT
6 Manufacturing Enterprises. And at some point
7 when we completed the spinoff, we needed a
8 receiver for those assets. So Water IP
9 Holdings LLC was created for that.

10 Q. And there is some discussion either
11 before or after this email about wanting to
12 keep the filings of trademarks anonymous at
13 least from being named under the name of ITT.
14 What do you recall about that?

15 A. That's correct. That there was a
16 desire to keep the identity, at least at the
17 time we were negotiating or at least prior to
18 making any kind of a trademark application
19 filing, secret.

20 Q. And I think you referenced earlier
21 a concern if NA learned of that, that they
22 might attempt to file their own trademark
23 applications?

24 A. Yeah. Just a preemptive filing.
25 We just wanted to make sure that we didn't

1 P. Van Winkle

2 have a preemptive filing.

3 Q. Was there any other reason for
4 forming Water IP Holdings LLC and registering
5 the trademarks under that name?

6 A. Water IP Holdings, LLC, was not
7 formed for the purpose of keeping trademarks
8 secret, the trademark filing secret. It just
9 happened to be -- it wasn't named by myself.
10 It was named by somebody else. As they were
11 creating new legal entities in the context of
12 the spin, they were naming them with what I
13 would call pretty generic names, water being
14 because it would -- there was WaterCo in the
15 spin, and there was DefenseCo in the spin,
16 so.

17 Q. The last sentence of your first --
18 I guess it's the first major paragraph where
19 it begins with "According to Dun &
20 Bradstreet." Do you see that?

21 A. No, I don't.

22 Q. It may actually be the beginning of
23 a new paragraph. It's indented slightly.

24 A. I'm sorry. Yes. Okay. Now I see
25 it.

1 P. Van Winkle

2 I guess the bottom of the last page it
3 appears to be an email from you dated June 8
4 of 2011 to Sarah, who I believe is Sarah
5 Bellamy at Lippincott. And let me ask you
6 first, is Sarah Bellamy the person that you
7 dealt with at Lippincott?

8 A. Yes.

9 Q. At the conclusion of your email to
10 her, you asked, "Does Lippincott concur with
11 this plan given the risk of revealing ITT's
12 identity?" And I may be a little bit
13 confused, but I was thinking that it was the
14 water holdings company that was going to hold
15 the trademark, so I'm just confused as to how
16 the identity would occur or revealing the
17 identity would occur.

18 A. Bear with me for a minute.

19 Q. Well, I may be answering my own
20 question.

21 A. Okay.

22 Q. It looks like there's a decision
23 being made to reach out to the Spanish
24 company NA and engage them in coexistence
25 agreement discussions.

1 P. Van Winkle

2 A. Yeah. The trademark filing and the
3 reaching out to Xylema were at least being
4 contemplated as happening almost at the same
5 time. And I believe there was a -- from a
6 strategy perspective, we preferred to have --
7 to try to lock in our rights first before
8 engaging in the negotiations.

9 And then I believe Frank had some
10 concerns about, you know, not revealing the
11 identity of ITT, at least at the time -- if
12 we went and engaged with NA first, then there
13 was a risk that -- they probably wouldn't
14 deal with us anyways if they didn't know who
15 we were. So it was just really trying to
16 flesh out the strategy of filing first and
17 then negotiating.

18 Q. And was there any sense that by
19 filing and holding the trademark
20 applications, that ITT was in a stronger
21 position?

22 A. I wouldn't say that so much as that
23 we didn't want to reveal, at least, again,
24 now that I look at this email a little bit
25 and think about it a little bit more, it was

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P. Van Winkle

MR. SHAUGHNESSY: No questions
here, but we'll read and sign.

VIDEOGRAPHER: We're now going off
the record approximately 5:35 p.m., end
of disk three, end of the deposition for
Peter Van Winkle.

(Time noted: 5:35 p.m.)

PETER VAN WINKLE

Subscribed and sworn to before me
this ____ day of _____, 2012.